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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,297	01/18/2002	Martin Caldwell	A-2136-AL	8404

7590 02/12/2004

Richard L. Myers
22872 Avenida Empresa
Rancho Santa Margarita, CA 92688

EXAMINER

ROBERT, EDUARDO C

ART UNIT	PAPER NUMBER
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3732

5

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,297

Applicant(s)

CALDWELL ET AL.

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 14-63 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☒ Claim(s) 10-13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Species I, Figures 1, in Paper No. 4 is acknowledged.

It is acknowledged that applicants believe claims 1-13 and 43-48 read on the elected Species I. It is noted that comparison of the claims with Species I, i.e. Figures 1-6, and the specification shows, however, that the Species I does not have a retractor as required in claims 43-48. Furthermore, the Species which discloses a retractor is Species IV, i.e. Figure 10, see applicant's specification, page 17, line 22, through page 19, line 12.

Also, in the instant application there is no generic claim. Claim 1 is not a generic claim. A generic claim has to read on all the different Species, i.e. Species I-IX.

Claims 14-63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

This application is in condition for allowance except for the following formal matters:

Priority

In the declaration applicants appear to claim the benefit of an earlier filing date under 35 U.S.C. 120 to a PCT application, i.e. PCT/IE/00/00092 filed on 07/28/2000. However, applicants

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have not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120. Applicants have not complied with any of the requirements which are:

- (1) **An appropriate reference to the prior PCT application**, including relationship, either in the application data sheet or in the first sentence of the specification (see MPEP 1895).
- (2) The U.S. national application must be **copending with the prior PCT application** (see MPEP 1895); and
- (3) The U.S. national application must have **at least one inventor in common** with the prior PCT application (see MPEP 1895).

The examiner must ascertain (1) and (2) above by either examining the national stage application filed of the international application, or by examining the international application filed. It is noted that neither of the national stage application filed of the international application or international application filed are available to the examiner. Thus, in this case the examiner must require applicants to submit sufficient "evidence" to prove that the international application was copending with the U.S. national (35 U.S.C. 111(a)) application claiming benefit under 35 U.S.C. 120. See MPEP 1895 for what the evidence should include.

The application, for examination purposes, will be considered as not having the benefit under 35 U.S.C. 120.

Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Ireland on 07/30/1999 and 09/27/1999. It is noted, however, that applicant has **not filed a certified copy of the applications as required by 35 U.S.C. 119(b)**. Furthermore, it is noted that the United States application was filed more than twelve months after the Irish applications and applicants have not complied with the requirement under 35 U.S.C. 120. Thus, the

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application, for examination purposes, will be considered as not having the benefit under 35 U.S.C. 119(b).

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

The abstract of the disclosure is objected to because it contains phrases that can be implied, e.g. "An improved". Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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The disclosure is objected to because of the following informalities: the various section of the specification should be preceded by their respective headings. Appropriate correction is required.

Claim Objections

Claims 10-13 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not depend or refer back to another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 10-13 not been further treated on the merits.

Allowable Subject Matter

Claims 1-9 are allowed.

Claim 10-13 are objected to as being improper multiple dependent claims, but would be allowable if rewritten in proper dependent form.

Conclusion

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

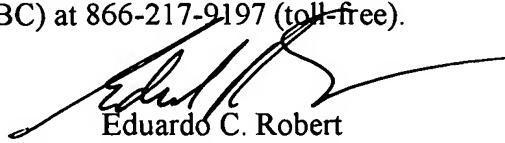
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Please be advised that a response to this office action should include a cancelation to the non-elected claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C.R.